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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,905	11/26/2003	Lester F. Ludwig	A8680	6289

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EXAMINER	
REILLY, SEAN M	

ART UNIT	PAPER NUMBER
2153	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/721,905	LUDWIG ET AL.	
	Examiner	Art Unit	
	Sean Reilly	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 March 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *51-108* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *51-108* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This Office action is in response to the appeal brief filed on December 18, 2006 and the amendment filed on March 15, 2007. Claims 51-108 are presented for further examination. The claims filed on March 15, 2007 were previously indicated allowable however upon further search and consideration these claims are no longer deemed allowable. An interview was conducted with Applicant on April 30, 2007 regarding this application and the other co-pending applications claiming similar subject matter. During this interview various claim amendments were discussed however agreement could not be reached. Based on the discussions during this interview it is expected that each of these related applications will proceed to the Board of Appeals and Patent Interferences. As requested by Applicant, the amendment filed on March 15, 2007 is **entered**.

In view of the Appeal Brief filed on December 18, 2006, PROSECUTION IS HEREBY REOPENED. A new rejection rationale is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have

been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

GLENTON B. BURGESS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. The instant claims are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of the following set of applications 11/622,583, 11/622,627, 11/623,177, 11/623,387, 11/623,630, 11/624,351, 11/624,860, 11/265,059, 11/264,926, 11/164,936, 11/165,156, and 11/165,394. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

2. Although the conflicting claims are not identical, they are not patentably distinct from each other. Refer to the tables below for an example of the mapped claim language that is similar in meaning and scope. Applicant is requested to contact the Examiner should Applicant require explicit mappings for each and every combination of the claim sets. However it is presumed that the rationale set forth below will easily translate over to the other claim sets and that the rationale is self-evident given how closely related these applications are.

Instant Application # 10/721,905	Application # 11/624,351
Independent claim 51 (unless otherwise noted). A method of real-time communication between a plurality of users, the method comprising:	Independent claim 1 (unless otherwise noted). A method of communication between first and second users using a system having respective first and second communication devices, each registered with at least one communication network and being capable of at least one communication type, the method comprising:
Providing a first user with collaboration	each registered with at least one

initiation software on an associated first communication device having defined communication capabilities	communication network and being capable of at least one communication type, the method comprising;
Keeping track of the communication capabilities of the first communication device;	4. causing registration of at least one communication service capability of the first communication device,
Allowing the first user to log in at the first communication device and connect to at least one communication network;	Allowing the first user to connect to at least one communication network by using the first communication device
61. the second communication device is a wireless device	The first communication device being configured for wireless communication
Associating the first user with the location of the first communication device;	Sending to the system, from the first communication device, information indicating the location of the first user to thereby enable the system to maintain at least one service record including at least the first user's location information
Causing display of a user identifier for at least the second user in a list on a display of the first communication device and allowing the first user to selected the displayed second user's identifier; and	Allowing the first user to request communication with the second user by selecting an identifier for the second user, from a list of displayed user identifiers displayed to the first user in a personal user directory,

55. allowing the first user to select a communication capability and wherein the real-time communication is further established based on the communication capability selection.	and by selecting one of a plurality of communication types
If the second user is not logged in indicating to the first user that the second user is not logged in	8. indicating to the first user if the second user has not logged in.
If the second user is logged in, responding to the selection by obtaining an address associated with a second communication device into which the user has logged in	In response to the request, causing retrieval of location information from a service record for the second communication device;
Using the obtained second user's address to enable real-time communication with the second user.	Initiating communication of the selected type from the first to the second device using the at least one communication network and the retrieved address information.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 51-108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swinehart (Telephone Management in the Etherphone System, published May 1989) and Vin et al. (Multimedia Conferencing in the Etherphone Environment; hereinafter Vin) and Ahuja et al. (U.S. Patent Number 5,689,553; hereinafter Ahuja) and Harrison et al. (U.S. Patent 5,796,727; hereinafter Harrison) and Banks (America Online: A Graphics Based Success Evaluation, published January 1992) and Baumgartner et al. (U.S. Patent Number 5,195,086; hereinafter Baumgartner).

Note the Swinehart and Vin references discuss the same system, the Etherphone system developed at the Xerox Palo Alto Research Center. The references are very much like multiple chapters in a book describing various aspects of the Etherphone system. Thus, it clearly would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to combine the two references as they describe the same system.

With regard to claims 51 and 61, Swinehart and Vin disclosed a method of communication between first and second users using a system having respective first and second communication devices (e.g. Swinehart multipurpose workstations, pg 1, section 2), each registered with at least one communication network (Swinehart pg 1, section 2; "each workstation is connected to a communication network") and being capable of at least one communication type (e.g. Swinehart pg 1 introduction 1st ¶ "telephony, voice mail, voice annotation, and other multi-media document applications;" also see Vin pg 69 allowing video conferencing), the method comprising:

- providing a first user with collaboration initiation software on an associated first communication device (e.g. Swinehart pg 3, section 2.5 software running on each workstation for establishing a conference) having defined communication capabilities (e.g. Swinehart pg 1 introduction 1st ¶ "telephony, voice mail, voice annotation, and other multi-media document applications;" also see Vin pg 69 allowing video conferencing);
- keeping track of the communication capabilities of the first communication device (Vin pg 72, columns 2 and 3 - Best effort conferencing; see specifically column 3 2nd ¶ "The system would determine the media set dynamically based on hardware availability, forcing all participants to use the same media");
- allowing the first user to log in at the first communication device and connect to at least one communication network (Swinehart pg 1, section 2; "each workstation is connected to a communication network" and pg 2, section 2.3 "Logging in");
- associating the first user with the location of the first communication device (Swinehart, pg 2, section 2.3 logging in tells the system which workstation the user is at);
- causing display of a user identifier for at least the second user in a list on a display of the first communication device (Swinehart, pg 3, section 2.5 and figure 8; arranging a conference);
- allowing the first user to request communication with the second user by selecting the displayed second user's identifier (Swinehart, pg 3, section 2.5 and figure 8; arranging a conference);

- if the second user is logged in, responding to the selection by obtaining an address associated with the a second communication device into which the second user has logged in (Swinehart, pg 2, section 2.3 logging in tells the system which workstation each user is at, conferencing data is then routed to the appropriate workstations as needed; also see pg 4, section 3.2, "dynamic information linking users to workstations");
- causing a notification to the second user of the request including a notification of the first user's identity (Swinehart pg 2, section 2.2 Figure 6; displaying the incoming communication request from the originating first user "Frances Brodsky for Karmen" and allowing the second user to "answer" the request);
- if the second user accepts the request (Again refer to Swinehart pg 2, section 2.2 Figure 6; accepting a request) using the obtained second user's address to enable real-time communication with the second user (e.g. establishing a conference between each conference attendee at the appropriate workstations, Swinehart, pg 2, section 2.3 logging in tells the system which workstation each user is at, conferencing data is then routed to the appropriate workstations as needed) (see also arranging a conference Swinehart, pg 3, section 2.5, figure 8; and the associated control processes for handling a conference, Swinehart section 3.1 control server; Vin pgs 71 and 75 connection manager);
- wherein the real-time communication is established based on the communication capabilities of at least the first communication device (Vin pg 72, columns 2 and 3 - Best effort conferencing; see specifically column 3 2nd ¶ "The system would

determine the media set dynamically based on hardware availability, forcing all participants to use the same media").

As cited above Vin disclosed keeping track of the communication capabilities of the communication devices and establishing the real-time communication based on the communication capabilities of the communication devices. Furthermore as **additionally** evidenced by Ahuja such a communication establishing scheme was widely known at the time of Applicant's invention. In a similar conferencing system, Ahuja disclosed establishing conferences using any number of communication types such as audio, video, and data (Ahuja, Col 13, lines 62-67). Ahuja further disclosed tracking the communication capabilities for each of the communications devices in order to identify any mismatches in the media communications capabilities of the parties and thus ensure proper communication types are used when establishing a communications session (see inter alia Ahuja Col 14, lines 3-19). Thus, it clearly would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to track of the communication capabilities of each communication device and establish the real-time communication based on those communication capabilities, as disclosed by Ahuja, in order to identify any mismatches in the media communications capabilities of the parties and thus ensure proper communication types are used when establishing a communications session.

Swinehart disclosed indicating to the first user that the second user is not logged in if the second user is not logged in. For instance when the user is not logged in all conference requests to that user are routed to an attendant's workstation so that a message can be taken (see inter alia Swinehart pg 3, section 2.7). Furthermore as **additionally** evidenced by at least Banks it was widely known in the art at the time of the invention to notify users when other users not logged

while establishing communications so the user is made aware of the fact that the communication session cannot be made at this time (see for instance Banks pg 247). Thus, it clearly would have been obvious to one of ordinary skill in the art at the time of Applicant's invention notify users when other users not logged while establishing communications so that the user is made aware of the fact that the communication session cannot be made at this time (Banks pg 247).

Swinehart and Vin failed to disclose the use of wireless communication devices for establishing communications. Nonetheless the use of wireless networks for the transfer of voice/audio and other data communications was notoriously well known in the art at the time of Applicant's invention, as evidenced by at least Harrison (see inter alia Figure 2 and Col 5, lines 8-24 where mobile PCs utilize wireless communications to connect to various networks). The benefits of wireless connections as opposed to being tethered to a network via a physical cable are substantial and would clearly benefit many users by allowing them to stay connected from anywhere a wireless connection is available. Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to extend the conferencing features of Swinehart and Vin to wireless environments, in order to allow users to connect to conferences from anywhere a wireless connection is available.

With regard to claims 52, Vin or Ahuja disclosed keeping track of the communication capabilities is done by at least one server (see inter alia Vin pg 72, columns 2 and 3 - Best effort conferencing; see specifically column 3 2nd ¶ "The system would determine the media set dynamically based on hardware availability, forcing all participants to use the same media" or Ahuja Col 14, lines 3-19).

With regard to claims 53, Swinehart disclosed the first communication device registers the communication device with at least one server (Swinehart, pg 2, section 2.3 logging in tells the system which workstation each user is at).

With regard to claims 54, Swinehart disclosed at least on communication device is a computer (e.g. Swinehart multipurpose workstations, pg 1, section 2).

With regard to claims 55, Vin disclosed allowing the user to select a particular communication type when establishing communications (see inter alia Vin pg 72, columns 2 and 3 - Best effort conferencing; see specifically column 3 2nd ¶ "Use the desired media."). Furthermore Ahuja provided additional evidence of this concept. In a similar conferencing system, Ahuja disclosed establishing conferences using any number of communication types such as audio, video, and data (Ahuja, Col 13, lines 62-67). Ahuja further disclosed that the communication type or types for establishing a conference may be selected by the user (e.g. the media type is selected "depending on the wishes of the parties to the telephone call," see inter alia Col 13, line 61 – Col 14, lines 3). It clearly would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to allow users to select particular conference communication types when establishing conferences, as disclosed by Ahuja, so that users have the freedom to use only the conference communication types they desire or need. Such an implementation enhances the user's experience by not burdening the user with unwanted features (e.g. a user may not wish to share desktop applications when only an audio discussion is needed). Furthermore only implementing communication types that are required to facilitate a conference conserves network resources.

With regard to claims 56 and 58, Swinehart and Vin further disclosed that the communication compatibilities include one of the group consisting of audio, video, snapshot sharing, conference, file sharing, and data conferencing (e.g. telephony, voice mail, voice annotation, video conferencing, and other multi-media document application sharing, see Swinehart pg 1 introduction 1st ¶ and Vin pg 69). Note a snapshot may be interpreted as *a view of data at a particular instant in time*. Thus, the sharing of saved files anticipates this limitation. Furthermore even if a snapshot is intended to represent a picture then Examiner maintains that transferring snapshot pictures in a conferencing system would have had similar benefits in a conferencing system as do the transfer of documents, messages, audio, and video. Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the combined system to allow for the transfer of snapshot pictures, in order to allow users to easily and effectively communicate with each other.

With regard to claim 57, Swinehart disclosed the service capability includes data conferencing that includes text communication (see for instance the text on pg 3, figure 7 of Swinehart).

With regard to claim 59, Harrison disclosed the communication network is a WAN (see inter alia Figure 2).

With regard to claims 60 and 62, Swinehart disclosed the location information includes address information (Swinehart, pg 2, section 2.3 logging in tells the system which workstation each user is at, conferencing data is then routed to the appropriate workstations as needed; also see pg 4, section 3.2, "dynamic information linking users to workstations").

With regard to claim 63, Swinehart disclosed allowing the first user to: select a third user from among a plurality of potential users; and add the third user to an existing communication (e.g. adding user to an existing conference, Swinehart pg 2, section 2.4 and Vin pg 73, Figure B "Invite").

With regard to claim 64, Swinehart disclosed notifying the first user of an attempt by a third user to initiate a communication and allowing the first user to establish a communication with the third user (Swinehart pg 2, section 2.2 Figure 6; displaying the incoming communication request from the originating user "Frances Brodsky for Karmen" and allowing the user to "answer" the request and establish a communication session).

With regard to claim 65, Swinehart disclosed the real-time communication appears automatically on a display of the second communication device (e.g. upon accepting a conference the user does not need to provide any further action, see inter alia Swinehart pg 3, section 2.5).

With regard to claim 66, Swinehart disclosed maintaining at least one service record for at least one logged in user (e.g. maintaining a record of the user being logged on, Swinehart pg 2, section 2.3 logging in and pg 3, section 2.7 logging off), wherein the indication that the second user is not logged in occurs if no service record is found for the second user (e.g. when the system determines that the user is not logged (or in other words the system does not find a record indicating that the user is logged in) to a workstation then the system routes the conference request to an attendant computer indicating to the requesting party that the user is not logged in Swinehart pg 3, section 2.7).

With regard to claim 73, Swinehart disclosed the user identifier is in a personalized list (Swinehart, pg 3, section 2.5 and figure 8; arranging a conference and displaying the telephone directory for the particular user; "Telephone Directory for Karmen Foozle").

With regard to claim 74, Swinehart disclosed the personalized list includes at least one graphical icon representing a user (e.g. the clickable icon "Brodsky, Frances x4567" in Figure 8 Arranging a conference). Furthermore should one persuasively argue that a graphical icon is more than a text based icon, such as picture instead, then Examiner maintains that such a modification would be obvious in view of Baumgartner. In a similar conferencing system, Baumgartner disclosed establishing a conference by allowing users to click on a directory of pictures representing each user (see inter alia Baumgartner Figure 18 and Col 18, lines 57-62). Providing a picture for each user allows a user establishing a conference to easily identify the users they are attempting to connect with based on facial recognition. Thus, it would have been obvious to modify Swinehart's system to use a directory of pictures representing each user when establishing communications, as disclosed by Baumgartner, so that users establishing conferences can easily identify the users they are attempting to connect with based on facial recognition.

With regard to claim 75, Swinehart disclosed selecting a user includes clicking on an icon (e.g. the clickable icon "Brodsky, Frances x4567" in Figure 8 Arranging a conference).

With regard to claim 77, Swinehart disclosed allowing the first user to send an e-mail to a third user (Swinehart pg 3, section 2.7 "electronic mail").

With regard to claim 90, Swinehart and Vin failed to specifically recite that the user identifier is displayed in a list that is scrollable. Nonetheless Examiner takes official notice that

scrollable lists were widely used at the time of Applicant's invention to allow users to access data that can not fit within a single window. Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to utilize a scrollable list for Swinehart's user directory, in order to ensure that the user will be able to view all the contacts even when they cannot fit within a single window.

The remaining claims are rejected using a similar rationale as applied to the above claims.

Conclusion

4. The prior art made of record, in PTO-892 form, and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Reilly whose telephone number is 571-272-4228. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 15, 2007

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